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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,146	06/14/2002	Mark A. Kappel	126063	3242
27256	7590	09/13/2007		
Dickinson Wright PLLC 38525 Woodward Avenue Suite 2000 Bloomfield Hills, MI 48304			EXAMINER PHAN, THIEM D	
			ART UNIT 3729	PAPER NUMBER
			MAIL DATE 09/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/064,146

Applicant(s)

KAPPEL ET AL.

Examiner

Tim Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 9,13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief filed on 4/30/07, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellants must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing the Office Action below:

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Greco (US 4,215,468).

With regard to claim 1, Greco teaches an IC extracting tool, comprising:

- a piston assembly (Fig. 6, items 10, 43, 40) having a channel therethrough (Fig. 11, around items 43, 48, 41 & 22);
- a cross-member (Figs. 6-9, item 22) slidably receiving said piston assembly (Figs. 7-9, item 43), said cross-member having a slot (Fig. 7, item 23) therein, said cross-member having a post head (Fig. 7, item 20) sized to be received within a retraction feature (Figs. 1-2, items 20, 21 & 22), which function is to retract and to grab; and
- a pin (Fig. 7, item 30) positioned within said channel and slidably received within said slot.

With regard to claim 2, Greco teaches a piston (Fig. 6, item 43) having a first and second end (Fig. 6, ends of item 43).

With regard to claim 3, Greco teaches that the piston assembly has a handle (Fig. 6, item 40) disposed on a first end.

With regard to claim 4, Greco teaches that a channel (Fig. 11, around items 41 & 22) is disposed on a second end of the piston (Fig. 11, bottom of item 43).

With regard to claim 5, Greco teaches that the piston assembly comprises a grip (Fig. 6, item 33) having an opening (Fig. 6, around item 41) therethrough for slidably receiving said piston (Fig. 6, item 43) therethrough.

With regard to claim 6, Greco teaches a spring (Fig. 6, item 41) positioned on said piston between said handle and said grip, said spring urging said handle away from said grip.

With regard to claim 7, Greco teaches a first and second post (Fig. 7, item 20).

With regard to claim 8, Greco teaches that the pin (Fig. 7, item 30) has an angular shape.

With regard to claim 10, Greco teaches an IC extracting tool, comprising:

- a piston (Fig. 6, item 43) having a handle (Fig. 6, item 40) disposed on a first end and a channel (Fig. 11, around items 41 & 22) disposed on a second end;
- a grip (Fig. 6, item 33) having an opening (Fig. 6, around item 41) therethrough for slidably receiving said piston;
- a spring (Fig. 6, item 41) positioned on said piston between said handle and said grip, said spring urging said handle away from said grip;
- a sleeve (Fig. 11, item 12) adjacent to the grip for slidably receiving the piston;
- a cross-member (Fig. 7, item 22) adjacent to said sleeve, said cross-member having a slot (Fig. 7, item 23) therein, said cross-member having a post head (Fig. 7, item 20) sized to be received with a retraction feature (Figs. 1-2, items 20, 21 & 22), which function is to retract and to grab; and

- a pin (Fig. 7, item 30) positioned within said channel and slidably received within said slot.

With regard to claim 11, Greco teaches that the post comprises a first post and a second post (Fig. 7, item 20).

With regard to claim 12, Greco teaches that the pin (Fig. 7, item 30) has an angular shape.

Allowable Subject Matter

4. Claims 9 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Appellants' arguments in the Appeal Brief filed 4/30/07 have been fully considered but they are not persuasive for the following reasons:

A. Appellants presented an argument under a heading "The rejection of Claims 1-8 and 10-13" (Page 3, Section VII Argument of the Brief). It is noted that this heading is incorrect as the Final Action contains a rejection of Claims 1-8 and 10-12 under 35 USC 102(b) while Claims 9 and 13 stand objected as containing allowable subject matter.

Appellants argue that Greco fails to disclose “an extraction tool for the electrical connector” (Page 3, Section VII Argument, 2nd Paragraph of the Brief) as recited in the preamble of claim 1. Appellants further argue that Greco discloses a device for disconnecting an integrated circuit rather than a device for electrical connector. However, Appellants stated that their invention includes other devices for “disconnecting circuit boards and the like but are not subject to the present claims” (Page 3 of the Brief). Contrary to Appellants’ statement, the invention can indeed perform the disconnecting functions on circuit boards and the like as there is nothing claimed to prohibit it. Greco discloses an extraction tool that can similarly perform the disconnecting functions, i.e., to remove a first connector portion. More relevant, Greco discloses a tool that meets each and every claimed feature of the rejected claims.

Furthermore, it is submitted that the claimed preamble must be read within the context of the entire claim. The Examiner asserts that the body of the claims fully sets forth all of the limitations of the claimed apparatus/invention and the preamble merely states the purpose or intended use of the invention rather than any distinct definition of any of the claimed invention’s limitations, therefore the claimed preamble is not considered a limitation and is of no significance to the claim construction (See MPEP 2111.02 (II) and *In Re Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)). Moreover, the body of the claim is about the tool/apparatus structure and does not depend on the preamble for completeness but, instead, the structural limitations within the body are able to stand alone, therefore again, the preamble is of no significance to the claimed invention. (*In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Nevertheless, Greco does teach an extractor tool/apparatus and

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the teachings of that tool/apparatus structure do not distinguish over the body of the claims 1 and 10. Therefore, Greco at a minimum, suggests the claimed apparatus, including the preamble.

Appellants' assertions that Greco does not teach "a piston assembly and a cross-member slidably received **within** the piston assembly" (Page 4, 1st paragraph) are unfounded. First, the claimed invention does not have the limitation "**within** the piston assembly" but rather requires "a cross-member slidably receiving said piston assembly" (Claim 1, line 4); second, Greco does indeed teach "a piston assembly" (Fig. 6, item 10), which is an assembly of several items such as the piston or pusher bar (Fig. 6, item 43), the handle (Fig. 6, item 40) and "a cross-member (Fig. 6, item 22) slidably receiving said piston assembly", which is shown in Figures 7-8 where the cross-members (item 22) are extended and lay under the piston (item 43) as shown in Figure 7 then when a technician operates the tool, the cross-members (item 22) slide toward each other under the piston as shown in Figure 8. Therefore, the "cross-members slidably receive the piston" as claimed.

Appellants further argue (Page 4, 1st and 2nd Paragraph) that Greco fails to teach "a retraction feature of the connector portion" as cited in the preamble and Appellants insist that the retraction feature is part of the connector portion as recited in the claimed preamble. Again, the claimed preamble of claims 1 and 10 "A tool for removing a first connector portion having a retraction feature comprising:" merely recites the intended use of the tool and as explained above, a preamble is considered to be of no significance to the claimed invention, especially when the body of the claim does not depend on the preamble for completeness.

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B. Regarding Claims 2-8 and 11-12 (Page 5, 3rd Paragraph), Appellants fail to argue whether it is proper to reject under 102(b) as being anticipated by Greco. Therefore, the rejections of Claims 2-8 and 11-12 are maintained.

C. Regarding Claims 9 and 13 (Page 5, 4th & 5th Paragraph), Appellants' arguments are fully considered but these claims are not under appeal because there is no art rejection against these claims. Therefore, the objection of these Claims 9 and 13 are maintained.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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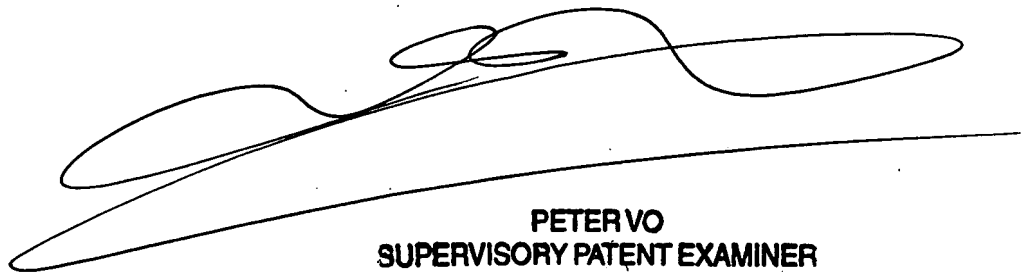
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Phan whose telephone number is 571-272-4568. The examiner can normally be reached on M & Tu, 6AM - 2PM, and W & Th, 9AM – 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tim Phan
Examiner
Art Unit 3729

tp
September 10, 2007

A large, stylized handwritten signature in black ink, likely belonging to Peter Vo, is written over the printed name and title.

PETER VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700